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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COBURN, CORBETT B

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

11/05/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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DETAILED ACTION

1. Newly added claims 67 & 68 have not been entered because they add new claims without cancelling an equal number of claims. They do **not** present new issues & would not require a new search since Brown's Fig 3 **clearly** teaches a continuous band. Applicant is hereby notified that should Applicant file an RCE request containing only these amendments, it will not be considered a *bona fide* attempt to further prosecution & that Examiner may issue a Final Rejection in response thereto. Applicant is urged to seek some other way to distinguish over the prior art.

Response to Arguments

2. Applicant's arguments filed 17 October 2008 have been fully considered but they are not persuasive.

3. Applicant argues that no reference has been cited showing indicia mounted on a moving band. Brown is concerned with little else. Brown's abstract states in pertinent part, "...a tape is adapted to be wound back and forth to display different visual information contained on the tape." The "visual information" corresponds to "indicia".

4. Applicant argues that Examiner must apply the so-called TSM test in order to show obviousness. Applicant is referred to *KSR Int'l Co v. Teleflex Inc.* which clearly states that while the TSM test is one test for obviousness, it is not the only such test. The court stated that the combination of known elements, performing their usual function in a known manner to yield predictable results is obvious.

5. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

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obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

6. In response to applicant's argument that Brown is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the problem to be solved is how indicia are to be displayed. The signage art is certainly a reasonable place for one of ordinary skill to look if trying to solve this problem. After all, the signage art is most closely concerned with this problem. Having looked to the signage art, one of ordinary skill would have quickly discovered any number of teachings to adopt the claimed structure – Brown is but one example.

7. Applicant argues that Nordman fails to teach player input devices that allows the player to dictate the position of the band or an indicator. This argument is not commensurate in scope with the claims. All the claims require is that the input devices have some effect on the movement. The input devices start the game & thus start the movement of the band.

8. If Applicant will amend his claims to correspond to this argument, Examiner agrees that this would distinguish over the current rejection. Examiner does not, however, commit to the patentability of such an amendment nor does Examiner say that Nordman & Brown might not render such a claim obvious if combined with another reference.

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9. Applicant argues that the references do not teach a continuous band. Applicant is referred to Brown's Fig 3.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Corbett B. Coburn/
Primary Examiner
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